

## REMARKS

Claims 10-13, 15, 17-19, and 54-61 are pending in this application. Claims 1-3, 5-7, and 48-53 are canceled in this response. Applicants thank the Examiner for indicating that the subject matter of claims 11 and 19 would be allowable if re-written in independent format. Claims 11 and 19 have been re-written in independent format, as suggested by the Examiner, and thus are in condition for allowance.

### *Request for Withdrawal of Finality of Office Action*

The Applicants submit that in view of the comments and amendments herein, all claims in this case are in condition for allowance. However, should any issues remain, Applicants respectfully request that the finality of the Office Action mailed May 6, 2003, be withdrawn. 37 C.F.R. § 1.113 specifies that a second action "may be made final," but finality in all instances is neither required nor appropriate. Accordingly, MPEP § 706.07, indicates that before final rejection is in order, a clear issue should be developed between the examiner and applicant. This MPEP section further states:

The applicant who is seeking to define or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.

However, the issues identified in this patent application as a basis for rejection of the pending claims are still being clarified. For example, the Office has not indicated where each and every element of the presently claimed invention can be identified in the cited art, which is a requirement for a rejection under 35 U.S.C. § 102(e), and which hinders the Applicants in responding to the rejection. Accordingly, withdrawal of the finality of the last Office Action is respectfully requested.

### *Information Disclosure Statement*

The Examiner indicated that he could not locate a copy of item no. 6 of the IDS filed December 9, 2002 (paper no. 17) in the parent application. A copy of that reference, US Patent Application Publication No. 2002/0022248 (to Jiangchun XU et al., published

As the original Information Disclosure Statement (Paper No. 12) mailed December 3, 2002 and given a filing date of December 9, 2002 is believed to have complied with 37 C.F.R. § 1.97, no additional requirements are believed to be due with the submission of this document. A copy of the form PTO-1449 previously submitted is enclosed; Applicants would appreciate the Examiner's consideration of US 2002/0022248 and initialing of item no. 6 on the form PTO-1449, and the return of the form PTO-1449 to the Applicants.

*Rejections/Objections*

The specification was objected to due to the blank lines concerning ATCC information on pages 39-40. These passages have been deleted from the application in the amendments to the specification above. Thus, this objection is rendered moot.

In the response filed June 10, 2002 and accorded a filing date of June 12, 002 (Paper No. 15), the paragraph at the bottom of page 9 bridging to page 10 regarding the ATCC deposits is also rendered moot by these amendments.

The Examiner indicated that claims 11 and 19 were objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form. Claims 11 and 19 are amended above accordingly. Claim 11 has been amended to incorporate the limitations of its base claim (claim 10). Claim 19 has been amended to incorporate the limitations of its base claim (claim 10) and its intervening claim (claim 18).

*Rejection under 35 U.S.C. § 102(e)*

Claims 10, 12-13, 15, 17-18, and 54-60 are rejected over Wong under 35 U.S.C. § 102(e). (Claims 1-3, 5-7, 48-51, and 53 are now canceled.)

Applicants strongly traverse this rejection. The Wong patent does not disclose the instantly claimed invention. Fundamental differences between the disclosure of the Wong patent and Applicants' present invention are summarized in the following table:

Disclosure:	Wong et al., U.S. Patent No. 6,166,194	Applicants' instant invention
Status of native gene or protein in cancer sample compared to normal sample:	↓	↑
To detect cancer check sample for:	Reduction or Lack of Levels of Native Gene or Protein <i>or</i> Increased Mutation of Gene or Protein	Enhancement of Levels of Native Gene or Protein Expression

Applicants submit that these are clear differences between the teachings of Wong and the Applicants' instant invention. For the presently claimed subject matter, it does not matter whether a protein set forth in Wong is identical to the protein in the instant invention.

The Wong reference teaches a particular protein, and indicates that it is altered, reduced or absent in cancer states. In accordance with Wong, if it were not altered, reduced, or absent, it would have suppressed the cancer state. Therefore any method based on the teachings of Wong would look for reduced or absent native protein. This teaches away from the claimed invention. Nothing in the Wong disclosure would guide one to look for enhanced native protein levels in cancerous tissue; conversely, there is nothing inherent about the Applicants' method based on the disclosure of Wong.

Accordingly, withdrawal of the rejection under 35 U.S.C. § 102(e) is respectfully requested.

*New Rejection*

*Rejection under 35 U.S.C. § 112, first paragraph*

Claims 54-61 were rejected under 35 U.S.C. § 112, first paragraph due to the lack of a statement indicating that the deposit of cDNA clone 20P1F12-GTC1 with the ATCC on February 12, 1999 and accorded deposit number 207097 complied with the requirements of 37 C.F.R. § 1.801-1.809. (Claims 48-53 are now canceled.)

A declaration to the effect that the deposit made on February 12, 1999 and accorded ATCC deposit number 207097 was made in accordance with 37 C.F.R. § 1.801-1.809 is enclosed. Thus this rejection is rendered moot.

### CONCLUSION

Applicants submit that all outstanding objections and rejections have been addressed by this response. The Examiner is invited to call the undersigned agent if the Examiner believes that any issues can be resolved via a telephone conference.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 511582000820.

Respectfully submitted,

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